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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/322,067 05/27/99 SKOLNICK

J 10886/047001

020985 HM12/0112  
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EXAMINER

BORIN, M

ART UNIT

PAPER NUMBER

1631

DATE MAILED:

01/12/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/322,067

Applicant(s)

Skolnick et al

Examiner

Michael Borin

Group Art Unit

1631



☒ Responsive to communication(s) filed on Nov 30, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-52 is/are pending in the application.

Of the above, claim(s) 23-42 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-22 and 43-52 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on 10/13/2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/322067 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Status of Claims***

2. The Examiner acknowledges the preliminary amendment filed 11/30/2000. Claims 6,7 are amended. Claims 1-52 are pending. In the previous Office action claims 1-19, 20-22, and 43-52 have been rejoined and examined together. Claims 23-42 have been withdrawn from consideration as drawn to non-elected invention. It is noted that applicant expressed the intention to cancel claims drawn to non-elected subject matter. Cancellation of claims 23-42 is, therefore, requested.

### ***Sequence Listing***

3. Applicant indicates that Sequence Listing is being submitted. Neither electronic nor paper form of the sequence Listing have been received.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-22 are drawn to a "functional site descriptor" and libraries of said descriptors. The product as claimed is not a process, machine, manufacture, or composition of matter. "Functional descriptive material" consisting of data structures is nonstatutory when claimed as descriptive material per se. MPEP 2106, section "1. Nonstatutory subject matter".

***Claim Rejections - 35 USC § 112, second paragraph.***

5. Claims 1-22,43-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims provide functional descriptor and for the method of making the descriptor, but, since the claim does not identify the "geometric descriptor" and the method claims do not set forth any particular steps involved in the method, it is unclear what product and method/process applicant is intending to encompass.

***Claim Rejections - 35 USC § 102 and 103.***

6. Claims 1,3-10,12,15-22, 43-50 are rejected under 35 U.S.C. 102(b) as anticipated by Holm et al. The rejection is maintained for the reasons of record. See paragraph #9 in the previous Office action (paper #9).

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Applicant seems to contrast "global" approach of the referenced method to more localized approach of the instant method drawn to set of constraints for "one or more atoms in two or more amino acid residues". As can be seen from the citation of the claim language, the language like "one or more" has only lower limit defined and is completely open in regard to the upper limit.

7. Claim 1-22 and 43-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallace et al. The rejection is maintained for the reasons of record. See paragraph #12 in the previous Office action (paper #9).

Applicant argues that nothing in Wallace suggests that a functional site descriptor can be represented by "non-catalytic backbone atoms". The instant claims, however are not limited to representation by "non-catalytic backbone atoms". Applicant also argues that Wallace does not suggest that an FSB incorporates one or more non-functional backbone atoms. Again, however, the claim language does not have a limitation of inclusion of non-functional backbone atoms. Also, there is no limitation that construction of FSB should not begin with all non-hydrogen side chain atoms.

***Conclusion.***

8. No claims are allowed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (703) 305-4506. Dr. Borin can normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to Friday. If

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attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Michael Woodward, can be reached on (703) 308-4028. The fax telephone number for this group is (703) 305-3014.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

December 15, 2000

mlb

A handwritten signature in cursive script, likely of the examiner or supervisor.

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